

REMARKS

Applicant thanks the Examiner for the careful consideration given to this application. Reconsideration is now respectfully requested in view of the amendment above and the following remarks.

Claims 1-38 are pending in this application. Claims 1, 19 and 38 are independent claims. Claims 1, 19, and 38 have been amended without prejudice herein. Reconsideration and allowance of the present application are respectfully requested.

Claim Rejections Under 35 U.S.C. §103

Claims 1-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,587,945 to Pasieka (hereinafter “Pasieka”) in view of U.S. Patent No. 7,295,677 to Simpson et al. (hereinafter “Simpson et al.”). These rejections are respectfully traversed for at least the following reasons.¹

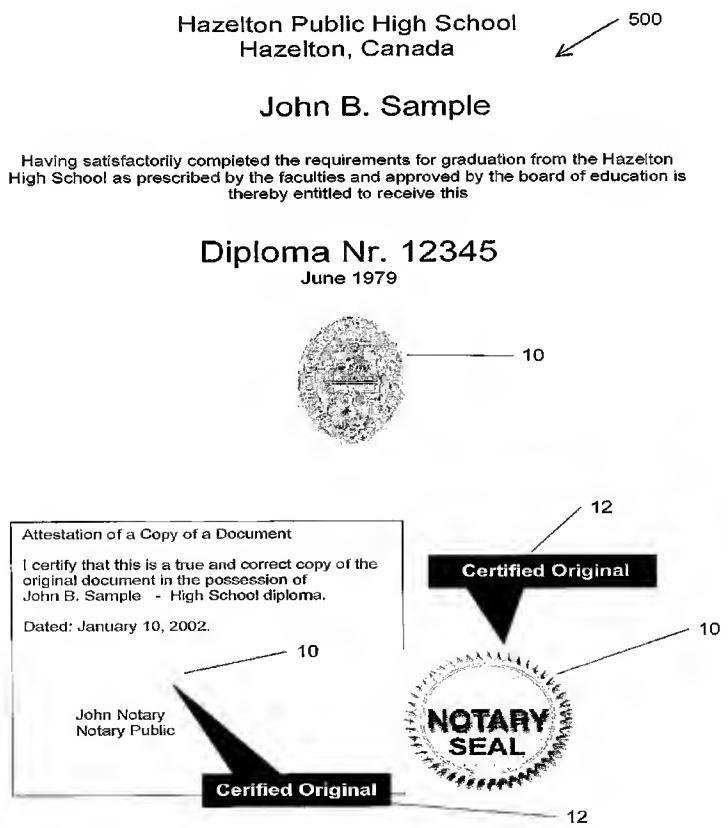
Obviousness is a question of law that is evaluated based on underlying factual questions about the level of skill in the art at the time the invention was made, the scope and content of the prior art, and the differences between the prior art and the asserted claim. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 at 1734, 1745 (2007), (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)). The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). Applicant may traverse the Examiner's *prima facie* determination as improperly made out. *In re Heldt*, 58 C.C.P.A. 701, 433 F.2d 808, 811, 167 USPQ 676, 678 (CCPA 1970). Applicant submits a *prima facie* case of obviousness is lacking, at least by virtue that the cited references fail, in any combination, to teach or suggest each of the elements of any of the pending claims.

As is discussed in the subject application, documents including, for example, certificates, diplomas, deeds, contracts, photos, legal documents and the like are collected by a central repository. *See, specification, pg. 2, par. [36].* For example, a paper document such as a

¹ The following discussion identifies exemplary reference characters, and/or references particular portions of the disclosure. Such identification and/or references do not constitute a representation that any claim element is limited to the embodiment illustrated at any identified character or described in any referenced portion of the disclosure.

diploma, certificate, or a notarized copy of a document or the like may be scanned using a scanner and posted to a website of the repository, to be accessed for authentication purposes by users through the internet. *See, specification, pg. 3 par. [39].* Documents which are scanned may be carefully examined, by verification authority, and verification information generated. *See, specification, pg. 3, par. [43].* The resulting verification information may be made available to persons who viewed selected scanned documents online. *Id.* The verification information may be presented to online viewers so as to appear on the electronic document image of the scanned document. *See, specification, pg. 3, par. [59-60].* Verification information may relate to one or more elements of the document. *See, specification, pg. 3, par. [45].*

FIG. 2



By way of further non-limiting example, and as is described in connection with Fig. 2 of the subject application (reproduced above), verification information inserted by the repository onto the electronic image appears as indicia 12. *See, specification, pg. 3, par. [62].* Marks 10, which may include signatures, seals, date stamps, ink stamps, embossing that were manually

applied to the paper document that was scanned, are flagged with indicia 12 so that persons viewing the electronic document online are informed which marks 10 are original. *Id.* Marks 10 which were photocopied or printed to the paper document which was scanned would not be flagged with indicia 12. *See, specification, pg. 4, par. [64].* Fig. 2 shows one mark 10 which was not flagged with indicia 12 because it is not original but rather a photocopy. *Id.*

Consistently, Claim 1 has been amended to recite:

A computer system, comprising:
a memory configured to store:
 electronic image data corresponding to an
 original tangible document, the tangible document
 having an electronic displayable verifiable
 provenance, and
 separately derived electronic displayable
 verification information corresponding to the
 electronic displayable verifiable provenance, and
 an output configured to provide said image data and
 said verification information for display by the user to
 authenticate the original tangible document,
 wherein the verification information is displayed on the
 image data.

Pasieka and Simpson fail in any combination to teach or suggest such a system.

For example, the Office action asserts Pasieka teaches a memory configured to store image data corresponding to an original document having an electronic displayable verifiable provenance at col. 4, lines 13-18. *See, 11/3/2009 Office action, pg. 3, ll. 1-6.* Applicant traverses this assertion. The cited Pasieka passage discusses that an author uses an imager to create an image, which is automatically sent to a server which signs and stores the image. *See, U.S. Patent No. 6,587,945, col. 4, ll. 13-18.* More particularly the Pasieka server hashes the image record using a one-way hash to produce an image fingerprint. *See Pasieka col. 4, ll. 43-44.* The Pasieka server encrypts the image fingerprint using the server's private key (or author's or imager's private keys stored in the server) to form an image signature. *See Pasieka col. 4, ll. 49-52.*

Claim 1 does not call for any mere image and provenance, but rather explicitly calls for "*an original tangible document ... having an electronic displayable verifiable provenance.*" A non-limiting example of such a document is shown in Fig. 2 of the subject application

(reproduced above), which includes marks 10. Contrary to Claim 1, neither the Pasieka image fingerprint nor the Pasieka image signature are included in the original document. Rather, and as is explained by Pasieka itself, the Pasieka server generates them. Accordingly, and contrary to the asserted rejections, Pasieka fails to teach or suggest at least “*an original tangible document, the tangible document having an electronic displayable verifiable provenance*” – as is recited by Claim 1.

Further, the Office action asserts Pasieka teaches separately derived electronic displayable verification information corresponding to the provenance at column 4, lines 49-55. *See, 11/3/2009 Office action, pg. 3, ll. 1-8.* Applicant traverses this assertion as well. Again, it may first be noted Pasieka fails to teach or suggest the recited provenance in the first place, such that it also necessarily fails to teach or suggest any verification information corresponding to it. Further, and as discussed above, the cited Pasieka passage discusses the server encrypting the image fingerprint using the server’s private key (or author’s or imager’s private keys stored in the server) to form an image signature. *See Pasieka col. 4, ll 49-52.*

Claim 1 instead explicitly calls for “*separately derived electronic displayable verification information corresponding to the electronic displayable verifiable provenance.*” A non-limiting example of such verification information is shown in Fig. 2 of the subject application (reproduced above), which includes indicia 12. Contrary to Claim 1, the Pasieka signature does not “*correspond[] to the electronic displayable verifiable provenance.*” Rather, it “provide[s] proof that the author is the originator of the image, and that the image has not been altered by others since it was signed.” *See Pasieka, col. 4, ll 52-55.*

Accordingly, and contrary to the asserted rejections, Pasieka also fails to teach or suggest at least “*separately derived electronic displayable verification information corresponding to the electronic displayable verifiable provenance.*” – as is recited by Claim 1.

Further yet, the Office action acknowledges that “Pasieka does not explicitly disclose that the verification information is displayed on the image data.” *See, 11/03/2009 Office action, pg. 3.* The Office action relies upon select teachings of Simpson in an effort to remedy this admitted shortcoming of Pasieka. However, Simpson fails to remedy this further substantial shortcoming.

Even assuming *arguendo* one would have been motivated to incorporate the purported visible watermark of Simpson into the Pasieka system, such a combination still fails to reach the

claimed invention. In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schneck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

As discussed above, Pasieka neither teaches nor suggests either: “*an original tangible document ... having an electronic displayable verifiable provenance*” and/or “*separately derived electronic displayable verification information corresponding to the electronic displayable verifiable provenance*” – as are recited by Claim 1. Similarly deficient, Simpson merely proposes systems and methods for adding watermarks using network-based imaging techniques. *See, col. 3 l. 61- col. 4 l. 8.* The Simpson watermark merely marks the primary image as the property of the owner (or marks the image in some other way, such as indicating that the primary image is a "draft" image). *See, Simpson, col. 5, ll. 8-12.* Thus, like Pasieka the Simpson information merely relates to an image in general, rather than “*an original tangible document ... having an electronic displayable verifiable provenance*” and “*separately derived electronic displayable verification information corresponding to the electronic displayable verifiable provenance*” – as are recited by Claim 1.

Accordingly, Applicants respectfully request the rejection of Claim 1 under 35 U.S.C. §103 be withdrawn, at least by virtue that Pasieka and Simpson fail both in alone and in combination to teach or suggest each of the limitations of Claim 1. Applicants also request reconsideration and removal of the rejections of Claims 2-18 as well, at least by virtue of these claims' ultimate dependency upon base Claim 1.

Turning to amended Claim 19, while of different scope it analogously recites:

A method of displaying a document for authentication,
comprising:
 creating electronic image data corresponding to
 an original document, *the original document having an*
 electronic displayable verifiable provenance;
 providing electronic, displayable verification
 information corresponding to the electronic displayable
 verifiable provenance; and

displaying the image data and the verification information, to permit a user to authenticate the original document,

wherein the verification information is displayed on the image data. (*Emphasis added*)

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §103 rejection of Claim 19 for at least the foregoing reasons as well. Applicant also requests reconsideration and withdrawal of the rejections of Claims 20-37, at least by virtue of these claims' ultimate dependency upon base Claim 19.

Turning to amended Claim 38, while also of different scope, it analogously recites:

A computer system comprising:

a unit for processing an electrical signal for displaying *a document having an electronic displayable verifiable provenance* for authentication to be received by a client computer operated by a user who wishes to authenticate the document, wherein the electronic signal comprises:

electronic image data corresponding to the document having the electronic displayable verifiable provenance; and

electronic, displayable verification information corresponding to the electronic displayable verifiable provenance,

wherein the verification information is displayed on the image data. (*Emphasis added*)

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §103 rejection of Claim 38 for at least the foregoing reasons as well.

Therefore, Applicants respectfully request that this rejection of claims 1-38 under 35 U.S.C. §103 be withdrawn.

Disclaimer

Applicants may not have presented all possible arguments or have refuted the characterizations of either the claims or the prior art as found in the Office Action. However, the lack of such arguments or refutations is not intended to act as a waiver of such arguments or as concurrence with such characterizations.

CONCLUSION

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees to Deposit Account No. 22-0185.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 27592-01057-US3 from which the undersigned is authorized to draw.

Dated: March 2, 2010

Respectfully submitted,

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